

**REMARKS / ARGUMENTS**

The present application includes pending claims 1-41, all of which have been rejected. By this Amendment, claims 2-3, 5-20, 34 and 36 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Initially, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicant assumes, based on the goals of patent examination noted above, that the present Office Action has set forth "all reasons and bases" for rejecting the claims.

Claims 11-20 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-41 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Publication No. 2002/0001386, issued to Akiyama (hereinafter, Akiyama). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

#### **REJECTION UNDER 35 U.S.C. § 101**

The Applicant first turns to the rejection of claims 1-20 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Regarding claims 11-20, the Office Action states:

Claims 11-20, define a *machine-readable storage* embodying functional descriptive material. However, claims do not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" - Guidelines Annex IV). That is, the scope of the presently claimed "machine readable storage" includes paper on which the program is written, which is non-statutory. The examiner suggests amending the claim to embody the program on "computer-readable medium" or equivalent in order to make the claim statutory. Any amendment to the claim should be commensurate with its corresponding disclosure.

See Office Action at pages 2-3. The Applicant has amended claims 11-20 as set forth above to address the above rejection under 35 U.S.C. § 101. Consequently, the Applicant submits that the rejection under 35 U.S.C. § 101 should be withdrawn.

## **REJECTION UNDER 35 U.S.C. § 102**

### **I. Akiyama Does Not Anticipate Claims 1-41**

The Applicant now turns to the rejection of claims 1-41 under 35 U.S.C. 102(b) as being anticipated by Akiyama. With regard to the anticipation rejections under 102(b), MPEP 2131 states that “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See *id.* (internal citation omitted).

#### **A. Rejection of Independent Claim 1 under 35 U.S.C. § 102(b)**

With regard to the rejection of independent claim 1 under 102(b), the Applicant submits that Akiyama does not disclose or suggest at least the limitation

of "generating at a first location a digital signature of a secure key to obtain a digitally signed secure key," as recited by the Applicant in independent claim 1.

Regarding claim 1, the Office Action states the following:

Akiyama discloses a method for secure key authentication, the method comprising: generating at a first location a digital signature of a secure key to obtain a digitally signed secure key (**Paragraph 0112, lines 7-10, "the contract information shown in FIG. 5 except for the digital signature is sequentially encrypted for respective blocks using the secret key, and the last block is used as a digital signature."**) *[It should be noted that, "contract information" contains the secret key, see at Fig. 5, "Work keys"]*

and transmitting the digitally signed secure key from the first location (**Fig. 1, Numeral 102**)

See Office Action at pages 3-4. The Examiner is relying on paragraph 0112 of Akiyama, which states the following, in relevant portions:

**[t]he contract information** shown in FIG. 5 except for the digital signature **is sequentially encrypted** for respective blocks using the secret key, and the last block is used as a digital signature.

See Akiyama at paragraph 0112. Therefore, in Akiyama **the contract information, which includes a plurality of work keys, is only encrypted using the secret key. Akiyama does not disclose or suggest that the work keys are also being signed** so as to generate digitally signed secure keys, as recited in

Applicant's claim 1. **The digital signature from the contract information of Figure 5 is separately authenticated, and is not used for signing any of the work keys within the contract information.**

For example, referring to Figures 1 and 5 of the Akiyama reference, the Applicant points out that the contract information certifying device 107 is used to authenticate the digital signature in the contract information of Figure 5. For example, the **contract information certifying device 107 certifies or authenticates the digital signature using key information stored in the digital signature authentication key storage 108**. If authentication fails, the device 107 sends back an error message via the individual information transceiver 102. If authentication succeeds, the device 107 stores channel contract information contained in the decrypted contract information in the contract information storage 121, and then sends a receipt acknowledgement indicating that update of contract information has terminated normally via the individual information transceiver 102. See Akiyama at paragraph 0111.

Therefore, the Applicant maintains that Akiyama does not disclose or suggest at least the limitation of "generating at a first location a digital signature of a secure key to obtain a digitally signed secure key," as recited by the Applicant in independent claim 1.

Furthermore with regard to the rejection of independent claim 1 under 102(b), the Applicant submits that Akiyama does not disclose or suggest at least

the limitation of "transmitting the digitally signed secure key from the first location," as recited by the Applicant in independent claim 1. The Examiner refers to the individual control information transceiver 102 of Figure 1. The Applicant points out that **the transceiver 102 only transmits error messages out of the apparatus 100**. See Akiyama at paragraphs 0110 and 0111. As it is clearly seen from Figure 1 of the reference, **information coming out of the contract information certifying device 107 is only communicated to storage devices 106, 108 or 121, and it is not transmitted by the transceiver 102**.

Therefore, the Applicant maintains that Akiyama does not disclose or suggest at least the limitation of "transmitting the digitally signed secure key from the first location," as recited by the Applicant in independent claim 1.

Accordingly, independent claim 1 is not anticipated by Akiyama and is allowable. Independent claims 11, 21 and 32 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11, 21 and 32 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

**B. Rejection of Dependent Claims 2-10, 12-20, 22-31 and 33-41**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, 21 and 32 under 35 U.S.C. § 102(b) as being

Application No. 10/769,173  
Reply to Office Action of March 13, 2007

anticipated by Akiyama has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-10, 12-20, 22-31 and 33-41 depend from independent claims 1, 11, 21 and 32, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-10, 12-20, 22-31 and 33-41.

Application No. 10/769,173  
Reply to Office Action of March 13, 2007

**CONCLUSION**

Based on at least the foregoing, the Applicant believes that all claims 1-41 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Ognyan Beremski', is written over a horizontal line.

Ognyan Beremski, Esq.  
Registration No. 51,458  
Attorney for Applicant

Date: 07-JUN-2007

MCANDREWS, HELD & MALLOY, LTD.  
500 WEST MADISON STREET, 34TH FLOOR  
CHICAGO, ILLINOIS 60661  
(312) 775-8000

/OIB